

***REMARKS***

This is a full and timely response to the outstanding Office action mailed August 22, 2005. Upon entry of the amendments in this response claims 1-15 are pending. More specifically, claims 1-3 are amended and claims 4-15 are added. These amendments are specifically described hereinafter.

**I. Present Status of Patent Application**

Claims 1-3 are rejected under 35 U.S.C. §102(b) as being anticipated by *Brown et al* (U.S. Patent Number 4, 899, 761). These rejections are respectfully traversed.

**II. Objections to the Specification**

The specification is objected to for the following informalities:

- A. At line 13 of page 1, the word – an – should allegedly be inserted before “interdiscal tensiometer apparatus” to indicate only one apparatus is disclosed in the application.
- B. At line 14 of page 1, the word – methods – should allegedly be replaced by the word – method -- to indicate only one method of use disclosed in the application.
- C. At line 18 of page 2, it is suggested to change “to achieving” to read – to achieve – to maintain appropriate tense.

Regarding the first two objections, the specification discloses more than one embodiment of apparatus and method. For example, the specification discloses alternate materials, shapes of components, etc., each of which could be considered a separate embodiment. Likewise, there is more than one method disclosed in the specification. Therefore, applicant respectfully submits that the specification should be amended to clearly indicate multiple apparatuses and methods. Applicant has amended the specification herein.

Regarding the third objection, the specification has been amended to maintain appropriate tense.

### III. Rejections Under 35 U.S.C. §102(b)

#### A. Claim 1

The Office Action rejects claim 1 under 35 U.S.C. §102(b) as allegedly being anticipated by *Brown et al.* (U.S. Patent No. 4,899,761). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1** as amended recites:

1. An interdiscal tensiometer, comprising:  
a load measuring means for measuring load between two points; and  
a distance measuring means for measuring distance between said two points;  
  
*wherein the load measuring means comprises a pair of primary members hingedly fixed together.*

(Emphasis added).

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Brown* does not disclose, teach, or suggest **wherein the load measuring means comprises a pair of primary members hingedly fixed together**. *Brown* does not disclose two members that are hingedly fixed together. The Office Action asserts that elements 34a and 34b disclose this feature. However, there is no hinging connection for elements 34a and 34b in *Brown*. Therefore, *Brown* does not anticipate 1, and the rejection should be withdrawn.

Additionally, the apparatus in *Brown* cannot be modified such that the members are hingedly fixed together. “If a reference would be ‘rendered inoperable for its intended purpose’ when it is modified for use as prior art, then the reference ‘teaches away’ and should not be used.” *In re Gordon*, 733 F.2d 900, (Fed. Cir. 1984). The members of the apparatus in *Brown*

move along a power screw. The apparatus determines the load and distance as measured along the power screw. If the members were hingedly fixed together, the members would not be movable along the screw and the apparatus would become inoperable for its intended function. Therefore, *Brown* can not be modified to disclose the apparatus as claimed.

B. Claim 2

The Office Action rejects claim 2 under 35 U.S.C. §102(b) as allegedly being anticipated by Brown et al (U.S. Patent No. 4,899,761). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 2** as amended recites:

2. An interdiscal tensiometer, comprising:

*a pair of primary members being hingedly fixed together*, each one of said pair of primary members having a contact tine;

a tension measuring device for measuring load of said contact tines;

a distance measuring device for measuring distance between said contact tines;

wherein said contact tines are adapted to engage a pair of intervertebral bodies such that said load measuring means can measure a load therein and said distance measuring means can measure a distance therebetween.

(Emphasis added).

Applicant respectfully submits that independent claim 2 as amended is allowable for at least the reason that *Brown* does not disclose, teach, or suggest **a pair of primary members being hingedly fixed together**. *Brown* does not disclose two members that are hingedly fixed together. The Office Action asserts that elements 34a and 34b disclose this feature. However, there is no hinging connection for elements 34a and 34b in *Brown*. Therefore, *Brown* does not anticipate 2, and the rejection should be withdrawn.

C. Claim 3

The Office Action rejects claim 3 under 35 U.S.C. §102(b) as allegedly being anticipated by *Brown et al.* (U.S. Patent No. 4,899,761). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 3** as amended recites:

3. A method of using an interdiscal tensiometer, comprising the steps of:
- providing a pair of primary members being hingedly fixed together*, each member of said pair of primary members having a contact tine;
- inserting each of said contact tines between at least two vertebral bodies;
- measuring a load between said at least two vertebral bodies; and
- measuring a distance between said at least two vertebral bodies.
- (Emphasis added).

Applicant respectfully submits that independent claim 3 as amended is allowable for at least the reason that *Brown* does not disclose, teach, or suggest **providing a pair of primary members being hingedly fixed together**. *Brown* does not disclose two members that are hingedly fixed together. The Office Action asserts that elements 34a and 34b disclose this feature. However, there is no hinging connection for elements 34a and 34b in *Brown*. Therefore, *Brown et al* does not anticipate 3, and the rejection should be withdrawn.

**IV. Rejections Under 35 U.S.C. §112**

The Office Action indicates that Claims 2 and 3 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As set forth above, claims 2 and 3 are amended to particularly point out and distinctly claim the subject matter. These amendments are made for purposes of clarification and not for reasons related to patentability over cited art. Therefore, Applicant respectfully asserts that the rejections have been accommodated.

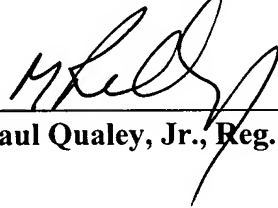
**V. Newly Added Claims**

Applicants respectfully submit that cited references fail to teach or suggest all features of newly added claims 4-15. Specifically, claims 4-6 are dependent claims that incorporate the limitations of independent claim 1, the allowability of which is set forth above. Claims 7-9 are dependent claims that incorporate the limitations of independent claim 2, the allowability of which is set forth above. Claims 10-13 are dependent claims that incorporate the limitations of independent claim 3, the allowability of which is set forth above. Therefore, claims 4-15 are allowable over any cited reference.

***CONCLUSION***

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-15 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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**Mail Stop Amendment  
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P.O. Box 1450  
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Date: November 22, 2005

  
Brooke French

In re application of: **Chappuis**

Confirmation No.: **8958**

U.S. Serial Number: **10/666,502**

Art Unit: **3736**

Filing Date: **September 19, 2003**

Examiner: **Smith, Fangemonique A.**

Our Reference Number: **50313-1110**

Title: **Interdiscal Tensiometer Apparatus and Method for Use**

**Response to Non-Final Office Action**

**Total Pages Transmitted (including cover sheet) - 12**